



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:) Examiner: Thien Minh Le
Stephane Bolognini)
Serial No. 10/566,744) Art Unit: 2887
Filing Date: February 1, 2006)
PROCESS AND APPARATUS FOR)
PROVIDING MARKINGS ON)
SECURITY PAPERS) April 23, 2008

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to the duty of disclosure embodied in 37 CFR § 1.56, Applicant wishes to formally bring to the attention of the Examiner the following information recently cited in a parallel European patent application proceeding.

The reference is listed on the attached Form PTO/SB/08A.

A copy of the non-US patent application cited references are attached hereto.

No fees associated with this filing are believed to be due, but if any are deemed to be due, charge the fees therefore to Deposit Account 12-2424.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 23, 2008.

Clifford W. Browning
Name of Registered Representative

Clifford W. Browning
Signature

April 23, 2008
Date

The filing of this Information Disclosure Statement shall not be construed as an admission that the information cited is, or is considered to be, material to patentability as defined in §1.56(b).

US Patent No. 5,944,356 corresponds to WO 94/15319, which was cited in a parallel proceeding in Europe.

US Publication No. 2006/0145468 corresponds to WO 2004/009371, which was cited in a parallel proceeding in Europe.

European Patent No. 1224650 (in English) corresponds to WO 01/59745, which was cited in a parallel proceeding in Europe.

Australian Patent No. AU 648992 corresponds to EP 0420261, which was cited in a parallel proceeding in Europe.

WO 01/59745 (a German – language reference) concerns a label (3) marked by means of a laser beam (2), which, in addition to macroscopic lettering (37, 38), features microscopic lettering (39), wherein the microscopic lettering (39) is concealed in the macroscopic lettering (37, 38).

In fact the label disclosed in this document is provided with an adhesive layer (layer 33 in figs. 3 and 5, layer 34 in fig. 4 and layer 363 in fig. 8) disposed on a support layer 4, and a marking 38, 39 is provided on the front side of the label by means of a laser. It is therefore obvious that the marking of WO 01/59745 cannot be visible from the rear or verso side of the label, but is rather merely meant to be visible for the front side of the label. In contrast, according to the applicant's invention, it is actually the rear side (the so-called "second side" in claim 1) and not the front side (the so-called "first side" in granted claim 1) of the substrate of the security document which is provided with a laser-inscribed marking.

Furthermore the feature related to the fact that the layer of material is "*capable of absorbing a substantial amount of radiation*" is not taught in WO 01/59745. In WO 01/59745, the laser works to ablate a portion of a metallic layer 321 (p. 8, lines 15-16) so that an underlying contrasting layer ("*kontrastbildende Schicht*") 322 is rendered visible from the front side of the document (see Figure 3). According to an alternate embodiment taught in WO 01/59745, the contrasting layer 322 might be omitted and the adhesive layer 33 be replaced by a coloured contrasting adhesive layer 34 resistant to the laser radiation (see page 9, lines 23-28, and Figure 4). In other words, there is no doubt that the laser-induced marking will only be visible from the same side as where the laser used to create the marking is located, i.e. from the front side of the label.

Accordingly, WO 01/59745 does not teach the inventive approach defined in claim 1 wherein a portion of the **second side** of the substrate of the security document is provided with a layer of material capable of absorbing a substantial amount of radiation emitted by the laser beam and wherein the laser beam is directed onto said layer of absorbing material **through** the first side and **across** the substrate to form the second identity marking **only** on the second side of the substrate.

In contrast, as already mentioned, WO 01/59745 does not teach to provide a marking on the rear side of a document, but rather merely on the front side of the document. Again, according to D4, the laser works to eliminate a portion of a metallic layer 321, so that an underlying contrasting layer ("*kontrastbildende Schicht*" 322 in Figure 3 or "*kontrasbildende Klebstoffschicht*" 34 in Figure 4) is rendered visible from the front side of the document.

Respectfully submitted,

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